



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,681	03/16/2004	Hideo Ando	249726US2SDIV	1656

22850 7590 11/02/2006

C. IRVIN MCCLELLAND  
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

NGUYEN, HUY THANH

ART UNIT	PAPER NUMBER
----------	--------------

2621

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/800,681

Applicant(s)

ANDO ET AL.

Examiner

HUY T. NGUYEN

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 20-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 20- 24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 7,106,952.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 20-24 of the present application and claims 1-4 of U.S. Patent No. 7,106,952 is that claims 1-4 of U.S. Patent No.

7,106,952 additionally recite that the still video object further comprising sub-picture stream and entry information for sub-picture stream that is not found in claims 20-24 of the present application. However, it is noted that elimination apart is obvious to

Art Unit: 2621

one of ordinary skill in the art . See Elimination of an element and its function---In re Karlson, 153 USPQ 184 (CCPA 1963).Therefore, it would have been obvious to one of ordinary skill in the art to modify claims 1-4 of U.S. Patent No. 7,106,952 by eliminating the subpicture steam and entry information recited in claims 1-4 of U.S. Patent No. 7,106,952 to produce claims 20-24 of the present application .

3. Claims 20- 24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 16-19 of copending Application No. 1/800,757 . Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 20-24 of the present application and claims 16-19 of copending Application No. 1/800,757 is that claims 16-19 of copending Application No. 1/800,757 additionally recite that the still video object further comprising sub-picture stream and entry information for sub-picture stream that is not found in claims 20-24 of the present application . However , it is noted that elimination apart is obvious to one of ordinary skill in the art . See Elimination of an element and its function---In re Karlson, 153 USPQ 184 (CCPA 1963).Therefore, it would have been obvious to one of ordinary skill in the art to modify claims 16-19 of copending Application No. 1/800,757 by eliminating the subpicture steam and entry information recited in claims 16-19 of copending Application No. 1/800,757 to produce claims 20-24 of the present application .

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 20- 24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 16-19 of copending Application No. 1/800,683 . Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 20-24 of the present application and claims 16-19 of copending Application No. 1/800,683 is that claims 16-19 of copending Application No. 1/800,683 additionally recite that the still video object further comprising sub-picture stream and entry information for sub-picture stream that is not found in claims 20-24 of the present application . However , it is noted that elimination apart is obvious to one of ordinary skill in the art . See Elimination of an element and its function---In re Karlson, 153 USPQ 184 (CCPA 1963). Therefore, it would have been obvious to one of ordinary skill in the art to modify claims 16-19 of copending Application No. 1/800,683 by eliminating the subpicture steam and entry information recited in claims 16-19 of copending Application No. 1/800,683 to produce claims 20-24 of the present application .

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 20-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 16 and 19-20 of

Art Unit: 2621

copending Application No. 11/342,862. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 20-24 of the present application and claims 16 and 19-20 of copending Application No. 11/342,862 is that claims 1 and 19-20 of copending Application No. 11/342,862 additionally recite that the still video object group information further comprising a play list search pointer that is not found in claims 20-24 of the present application. However, it is noted that elimination apart is obvious to one of ordinary skill in the art. See Elimination of an element and its function---In re Karlson, 153 USPQ 184 (CCPA 1963). Therefore, it would have been obvious to one of ordinary skill in the art to modify claims 16 and 19-20 of copending Application No. 11/342,862 by eliminating the recited play list search pointer claims 16 and 19-20 of copending Application No. 11/342,862 and to produce claims 20-24 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 20-24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 16 and 19-20 of copending Application No. 11/342,859. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between claims 20-24 of the present application and claims 16 and 19-20 of copending Application No. 11/342,859 is that claims 1 and 19-20 of copending Application No. 11/342,859 additionally recite that the still video object group information further comprising a

Art Unit: 2621

play list search pointer that is not found in claims 20-24 of the present application .

However , it is noted that elimination apart is obvious to one of ordinary skill in the art .

See Elimination of an element and its function---In re Karlson, 153 USPQ 184 (CCPA 1963). Therefore, it would have been obvious to one of ordinary skill in the art to modify claims 16 and 19-20 of copending Application No. 11/342,859 by eliminating the recited play list search pointer claims 16 and 19-20 of copending Application No. 11/342,859 and to produce claims 20-24 of the present application .

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T. NGUYEN whose telephone number is (571) 272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

H.N

HUY N. NGUYEN  
PRIMAR EXAMINER